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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/089,298	03/29/2002	Uwe Kaltenbom	004501-647	9345
21839	7590	12/09/2003	EXAMINER	
BURNS DOANE SWECKER & MATHIS L L P			PENG, KUO LIANG	
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ALEXANDRIA, VA 22313-1404			1712	

DATE MAILED: 12/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/089,298

Applicant(s)

KALTENBORN, UWE

Examiner

Kuo-Liang Peng

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 3/29/02 preliminary amendment.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4 and 10-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 10-18 is/are rejected.
- 7) ☒ Claim(s) 4 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3/29/02.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: See Continuation Sheet.

Continuation of Attachment(s) 6). Other: English translation of JP 07-316432.

### DETAILED ACTION

1. The Applicants' preliminary amendment filed on March 29, 2002 was received. Claims 1-4 and 10-18 are amended.

#### *Specification*

2. The disclosure is objected to because of the following informalities:  
In [0015], should "R is a bivalent" be -- R is a monovalent --?  
In [0018], the formula (IV) is not consistent with "3-glycidoxypropyl".  
Appropriate correction is required.

#### *Claim Objections*

3. Claim 4 is objected to because of the following informalities:  
In Claim 4 (line 2), should "[component (i)]" be -- (component (i)) --?  
Appropriate correction is required.

#### *Claim Rejections - 35 USC § 101*

4. 35 U.S.C. 101 reads as follows:  
  
Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.
5. Claims 13-16 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for

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example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 3-4, 10 and 13-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In Claim 3 (line 2), "preferably" causes confusion because it is not clear as to what is the non-preferred embodiment.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 4 recites the broad recitation "an integer from 1

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to 1 000" (last line), and the claim also recites "preferably an integer from 10 to 50" which is the narrower statement of the range/limitation. The same rejection applies to "preferably" recited in Claims 14 and 15 and "or else" in Claim 15.

Claim 10 recites the limitation "claim 6" in lines 1 and 8-9. There is insufficient antecedent basis for this limitation in the claim.

Claim 10 recites the limitation "R" in line 7. There is insufficient antecedent basis for this limitation in the claim. In the interest of compact prosecution, the R group is defined in the specification ([0028]).

Claims 13-16 provide for the use of a mold-release agent, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

In Claim 14 (line 3), the phrase "where appropriate" causes confusion because it is not clear as to whether Applicants intend to claim the subject of matter immediately after this phrase.

In Claim 15 (line 4), it is not clear as to what "DAP resins" refers to.

### ***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an

international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1-3 and 11-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Martin (US 6 294 007).

Martin discloses a silicone mold release composition comprising a hydrophobic-modified organopolysiloxane and organofunctional organopolysiloxane containing aminoorgano or mercapto functional groups (col. 2, line 42 to col. 6, line 58). The amount of the organofunctional organopolysiloxane can be used in an amount of 1, 3 or 5 wt% (Examples). A solvent can be used (col. 7, line 54 to col. 8, line 12). The silicone mold release composition can be used in a form of aqueous emulsion or dispersion (col. 9, lines 13-25). The organofunctional organopolysiloxane can further contain alkoxy groups (col. 4, line 64 to col. 5, line 2 and col. 6, line 59 to col. 7, line 23). Since the organofunctional organopolysiloxane reads on Applicants' component ii), it should be capable of reacting chemically in situ with the thermoset surface. The composition can further comprise additives described in col. 8, line 40 to col. 9, line 4). The mold release can be used in a process for molding polyurethane (col. 9, lines 10-27).

10. Claims 1-2, 13 and 17-18 are rejected under 35 U.S.C. 102(b) as being anticipated by JP363 (JP 62-240363).

JP363 discloses a release film comprising a polysiloxane containing alkenyl groups, a polysiloxane containing Si-H groups, an epoxy containing polysiloxane and a catalyst (page 2, lower left and right columns). The epoxy containing polysiloxane can be derived from 3-glycidoxypyltrimethoxysilane and can be used in an amount of 1.3 parts by weight (page 5,

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lower left column). Since the epoxy containing polysiloxane reads on Applicants' component ii), it should be capable of reacting chemically in situ with the thermoset surface. The English translation of the instant reference has been requested. It will be available later upon Applicants' request.

11. Claims 1-3 and 12-18 are rejected under 35 U.S.C. 102(b) as being anticipated by JP432 (07-316432).

JP432 discloses a silicone mold release agent for molding polyurethane, comprising A) a wax, B) an organic solvent soluble silicone resin, C) a amino group-containing polysiloxane, D) non-ionic emulsifier and E) water. The amounts of component B) and component C) can be from 10 to 30wt% and from 0.5 to 5 wt%, respectively. ([0007], [0014]-[0017] and [0031]). Since component C) reads on Applicants' component ii), it should be capable of reacting chemically in situ with the thermoset surface.

12. The references "EP 1305 838" and "EP 3 325 210" cited in PTO-1449 form filed on March 29, 2002 have been changed to "EP 305 838" and "EP 325 210", respectively, as indicated in the hard copies provided by Applicants.

13. Claims 4 and 10 would be allowable if rewritten to overcome the claim objection and/or the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.



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None of the above references teaches or fairly suggests the use of a) a polysiloxane having a formula (I) as set forth in Claim 4; and b) a specific reactive silane compound as set forth in Claim 10.

13. The "X" references cited in the international search report are not relied upon because of the following reason:


EP 305 838 does not teach or fairly suggest the use of a reactive silane compound corresponding to Applicants' component ii) in an amount set forth in the present invention.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuo-Liang Peng whose telephone number is (703) 306-5550. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Dawson, can be reached on (703) 308-2340. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

klp  
November 26, 2003

  
Kuo-Liang Peng  
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